IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of Irish et al.	) Group Art Unit: 3664
Serial No. 10/774,301	) Examiner:) Ronnie M. Mancho
Filed: February 6, 2004	
For: System And Method For Executing User-Definable Events Triggered Through Geolocational Data Describing Zones Of Influence	

RESPONSE TO NOTICE OF NON-COMPLIANT APPEAL BRIEF

Board of Patent Appeals and Interferences
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Notification of Non-Compliant Appeal Brief mailed on October 22, 2009, for the above-referenced patent application, please enter the following amendments and remarks.

Replacement Arguments to the Appeal Brief begin on page 2 of this paper.

Remarks/Arguments begin on page 11 of this paper.

7. REPLACEMENT ARGUMENT TO THE APPEAL BRIEF

A. Issue I

Claims 1-5 stand rejected under 35 U.S.C. § 112, first paragraph, for lack of enablement.

A reasonable basis to question the enablement provided for the claimed invention has not been shown.

1. Legal Basis

"The test of enablement is whether one reasonably skilled in the art could make or use the invention without undue experimentation." MPEP 2164.01 (citing *U.S. v. Telectronics, Inc.*, 857 F.2d 778, 785 (Fed. Cir. 1988)). However, to properly make the rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. MPEP 2164.04. "A specification disclosure, which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. § 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support." *Id.* Minimally, reasons for the uncertainty of the enablement are required to be provided, such as an explanation for doubting the truth or accuracy of any statement in a supporting disclosure (emphasis added). *Id.*

2. Claims 1-5

The Final Office Action of October 29, 2008 ("Office Action") fails to provide reasons and evidence to support doubt of the objective truth of the statements made in the disclosure. Instead, the Office Action asserts that in Claim 1, Applicant fails to provide meanings for the phrases "zone of influence," "event data," and "user navigational event." Office Action, page 2, paragraphs 3-5 and page 3, paragraph 6. The Office Action further states that each of the phrases

were "copied from the specification and pasted in the claims without any description to enable one skilled in the art to make and use the invention." *Id.* Applicant respectfully disagrees.

A reasonable basis to question enablement is required. However, the objective truth of the statements contained in the specification has not been called into doubt. Identifying phrases and stating that the phrases were copied without any description is not acceptable evidence or reasoning. Accordingly, a rejection for enablement is inappropriate.

Notwithstanding, Applicant has previously addressed the apparent concerns regarding the aforementioned phrases in the Office Action Responses of July 7, 2008 and December 29, 2008. Additionally, Applicant provides support for each phrase, which is both defined and enabled in the specification, below. During examination, words of the claim must be given their broadest reasonable interpretation, including their plain meaning, unless the plain meaning is inconsistent with the specification. MPEP 2111.01. Applicant asserts that the plain meaning of the phrases are consistent with the definitions provided in the specification and are objectively truthful. MPEP 2164.04.

The phrase "zone of influence" includes the term "zone," which means an area or region distinguished from adjacent parts by a distinctive feature or characteristic. American Heritage Dictionary 939 (3d ed. 1994). Further, the term "influence" means a power indirectly or intangibly affecting a person or a course of events. American Heritage Dictionary 430 (3d ed. 1994). Together the terms "zone" and "influence" refer to a distinguished area in which a course of events is affected. This definition is supported by the specification on page 10, line 30-page 11, line 1; page 13, lines 2-4; page 13, lines 11-13; page 13, lines 20-22; page 13, lines 27-29; page 14, lines 5-6; page 14, lines 10-13; and page 14, line 30-page 15, line 3. Examples of zones of influence are provided in FIGURES 2A, 2B, 3A, 3B, 4, 5A, 5B, 6, and 7.

The phrase "user event data" includes the term "event," which means an occurrence or incident. American Heritage Dictionary 293 (3d ed. 1994). In the application, the term "user" is combined with the term "event" to indicate a

specific type of event. Further, the phrase "user event" modifies the term "data" to describe a particular type of data. Additionally, the Office Action questions what event is referred to by the phrase. Claim 1 recites user event data configured to define one or more user navigational events.

The phrase "user navigational event" includes the term "event," which is modified by the terms "user" and "navigational" to identify a particular type of event. The root word "navigate" means to make one's way (through). American Heritage Dictionary 556 (3d ed. 1994). Thus, the phrase relates to an event in which a user makes his way through. Support for the phrase can be found in the specification on page 11, lines 5-7; page 15, line 4-page 16, line 6; page 16, line 7-page 17, line 9; and page 17, lines 28-30.

The Office Action also indicates that in Claim 2, the terms "timed event data" and "duration," and the phrase "to locally trigger each user navigational event associated with the timed event" are not enabled. Office Action, page 3, point 2, paragraphs 2, 3, and 6. The phrase "timed event data" includes the term "event," which means an occurrence or incident. American Heritage Dictionary 293 (3d ed. 1994). The root word "time" means a duration or a number, such as years, days, and minutes, that represent an interval separating two points on a continuum. American Heritage Dictionary 843 (3d ed. 1994). Together, the terms mean data regarding the duration of an occurrence. Support for the data can be located in the specification on page 8, lines 15-30; page 14, lines 15-17; and page 15, lines 7-8.

The term "duration" means a continuance in time or a period of existence or persistence. American Heritage Dictionary 264 (3d ed. 1994). Support for the term "duration" can be found in the specification on page 4, lines 5-7; page 8, lines 15-30; and page 22, lines 16-18. Further, support for the phrase "to locally trigger each user navigational event associated with the timed event" can be found in the specification on page 4, lines 6-7; page 8, lines 17-30; page 15, lines 4-8; page 16, lines 1-3; and page 22, lines 16-18.

In Claim 3, the phrases "independent trigger condition" and "to locally trigger each user navigational event associated with the independent trigger

conditions based on the trigger condition satisfaction" have been identified as not enabled. Office Action, page 3, paragraphs 4 and 5. In the phrase "independent trigger condition," the term "trigger" means an event that precipitates other events. American Heritage Dictionary 859 (3d. ed. 1994). The term "condition" means a prerequisition. American Heritage Dictionary 182 (3d ed. 1994). Thus, a combination of the terms describes a prerequisite for precipitating an event. The term "independent" modifies the phrase "trigger condition" to describe a type of trigger condition that is free from the influence, guidance, or control of others. American Heritage Dictionary 425 (3d ed. 1994). The phrase "independent trigger condition" is consistently defined, and not merely used, in the specification on page 9, lines 1-5.

Also, in Claim 3, the phrase "to locally trigger each user navigational event associated with the independent trigger conditions based on the trigger condition satisfaction" finds support in the specification on page 9, lines 1-7; page 11, lines 2-3; page 15, lines 4-11; and page 25, lines 10-16.

Further, the Office Action indicates that the phrases "user event data," "user navigational event," and "timed event data," as used in Claims 1-5, are not enabled. Office Action, page 3, paragraph 6. Applicant disagrees. The phrase "user event data" is discussed above with respect to Claim 1. The phrase "user navigational event" is discussed above with respect to Claim 1. The phrase "timed event data" is discussed above with respect to Claim 2.

Accordingly, a reasonable basis to question the enablement provided for the claimed invention has not been shown. Claims 1-3 are enabled. Claims 4 and 5 are dependent on Claim 1 and are patentable for the above-stated reasons, and as further distinguished by the limitations therein. As the specification provides a teaching sufficient so as to enable one skilled in the art to which the invention pertains, or with which the invention is most nearly connected to make or use the invention, withdrawal of the rejection is requested.

B. Issue II

Claims 2 and 3 stand rejected under 35 U.S.C. § 112, first paragraph, for

failing to comply with the written description requirement.

Claims 2 and 3 comply with the written description requirement.

1. Legal Basis

The test for the written description requirement requires that the specification describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. MPEP 2163(I). The Examiner carries the burden of presenting evidence or reasons why one skilled in the art would not recognize that the written description provides support for the claims. MPEP 2163(II). Specifically, the Examiner must set forth express finding of fact that should identify the claim limitations and establish a *prima facie* case by providing reasons why a person skilled in the art would not have recognized that the inventor was in possession of the application as filed. MPEP 2163.04(I). When a claim is amended or newly added, a general statement by the Examiner that the claims are not supported by the written description may be sufficient when support for the limitation is not apparent and applicant has not pointed out where the limitation is supported (emphasis added). *Id.*

2. Claims 2 and 3

In the Office Action Response ("Response") of July 7, 2008, Claim 2 was amended and now currently recites locally trigger each user navigational event associated with the timed event. Applicant specifically provided support for the amendment in the original specification on page 4, lines 6-7; page 8, lines 17-30; page 15, lines 4-8; page 16, lines 1-3; and page 22, lines 16-18. Response, page 11, lines 19-21. Further support for Claim 2 can be located in the specification on page 11, lines 2-3.

Claim 3 was also amended in the Response and now recites an evaluation module configured to determine trigger condition satisfaction of one or more of the independent trigger conditions. Support was specifically provided for the amendments on page 9, lines 20-24; page 11, lines 2-3; page 15, lines 4-11; and

on page 25, lines 10-16 of the original specification. Response, page 11, lines 24-26.

Therefore, Applicant has provided specific support for the amendments to Claims 2 and 3, per MPEP 2163.014(I). In light of the provided support, no evidence or reasons have been provided as to why a person skilled in the art would not have recognized that the inventor was in possession of the invention as claimed. Accordingly, a *prima facie* case for lack of written description has not been shown as Claims 2 and 3 are supported by the original specification.

C. Issue III

U.S. Patent No. 6,320,495, to Sprogis fails to anticipate Claims 1-5 under 35 U.S.C. § 102(e) and the rejection of the claims cannot stand.

Sprogis discloses a treasure hunt type game that utilizes global positioning satellite (GPS) equipped wireless communication devices (Abstract). Players are given clues or directions to proceed along a treasure hunt route based upon their location as determined by a GPS receiver (Abstract; Col. 2, lines 3-20 and 67-Col. 3, lines 4-18; Col. 5, lines 11-29). A gamemaster computer program (gamemaster) is designed to run the treasure hunt from a central Website (Col. 3, lines 4-5, 19-26 and 51-55). The gamemaster inputs a general map of the treasure hunt territory, which is divided into a plurality of smaller segments, each assigned a unique number (Col. 4, lines 15-19). The players' GPS receivers receive locational data, which is transmitted back to the gamemaster by the wireless communications device (Col. 3, lines 5-8). The gamemaster then determines the next clue to be given to a player based upon the player's location in relation to a particular segment, as well as other variables, such as the number of clues the player has correctly answered and the position of other players (Col. 2, lines 12-16; Col. 3, lines 9-15; and Col. 5, lines 8-25).

1. Legal Basis

A claim is anticipated under 35 U.S.C. § 102(e) only if each and every element as set forth in the claim is found, either expressly or inherently described,

in a single prior art reference. MPEP 1231.

2. Claims 1-5

Claim 1 recites a storage medium configured to hold data in a cartridge script loadable into a wireless computing device.

Sprogis fails to teach or suggest holding data in a cartridge script that is loadable into a wireless computing device. Instead, Sprogis teaches maintaining a gamemaster, which is a centralized computer that transmits data to and receives data from one or more wireless communication devices each managed by a separate player player (Col. 3, lines 32-34). The wireless communication device transmits a player's location to the gamemaster via the Internet (Col. 3, lines 34-36 and Col. 3, line 66-Col. 4, line 1). Once received, the gamemaster determines a clue based on the location of the player, as well as other factors (Col. 3, lines 9-13). The clue is then transmitted to the wireless communication device for display to the player (Col. 3, lines 61-63; and Col. 4, lines 9-13). Thus, the gamemaster functions independently from the wireless communication devices, which each collect and transmit the player location to the gamemaster for processing. The gamemaster is centralized for receiving data from and transmitting data to the multiple devices. In contrast, a cartridge, per Claim 1, is loaded onto a user device and together, the cartridge and user device function as a single, unified component. Therefore, Sprogis teaches a central gamemaster for communicating with multiple wireless communication devices, rather than a cartridge script that is loadable onto a wireless computing device.

Claim 1 further recites user event data configured to define one or more user navigational events into the cartridge script and to associate each user navigational event with at least one zone of influence.

Sprogis fails to teach defining one or more user naviation events into a cartridge script. Rather, Sprogis teaches determining a clue when a player enters a new grid on a treasure hunt territory map (Col. 5, lines 11-12). The clue is determined by a gamemaster based on the location of the player, a number of clues the player has answered correctly, and a location of other players (Col. 3,

lines 9-13). Once determined, the clue is transmitted to a wireless communication device for providing to the player (Col. 3, lines 13-15). Since the current locations of the player and other players are considered, the clue is determined *dynamically* by the gamemaster based on those locations. Therefore, Sprogis teaches *dynamically* determining clues by a gamemaster, rather than defining one or more location events into a cartridge script that is loadable into a wireless computing device.

Finally, Claim 1 recites the wireless computing device comprising . . . a processing module configured to determine a correlation between the dynamic geolocational data and the static geolocational data for one or more of the zones of influence and to locally trigger the user naviational event associated with the zone of influence based on the correlation.

Sprogis fails to teach or suggest a wireless computing device for determining a correlation between dynamic geolocational data and static geolocational data for one or more zones of influence and for locally triggering a user navigational event associated with the zone of influence based on the correlation. Instead, Sprogis teaches identifying by a wireless communication device, a location of a player, which is transmitted to a centralized gamemaster computer for processing (Col. 3, lines 5-9). A central map of a treasure hunt territory is divided into grids and input into the gamemaster to track player locations on the map using the player location determined by the wireless communication device (Col. 4, lines 15-27). When a player enters a new grid, the gamemaster uses the player location with previous locations of the player and current locations of other players to generate a clue, which is transmitted to the wireless communication device (Col. 3, lines 9-15 and Col. 5, lines 11-12). Since the central map is maintained on the gamemaster, the wireless communication device merely obtains the player location for transmitting to the gamemaster, where the player's location on the central map is identified. Without a map, the wireless communication device is unable to identify the player's specific location with regards to the treasure hunt. Therefore, Sprogis teaches identifying by a centralized gamemaster, a player's location on a central treasure hunt territory

map, rather than determining by a wireless computing device, a correlation between dynamic geolocational data and static geolocational data for one or more zones of influence.

Further, Sprogis fails to teach or suggest a wireless computing device for triggering a user naviational event associated with the zone of influence based on the correlation. Instead, Sprogis teaches determining a location of a player by a wireless communication device and transmitting the player location to a centralized gamemaster (Col. 3, lines 5-9). The gamemaster uses the player location from the wireless communication device to identify a location of the player on a central treasure hunt map, which is segmented into grids (Col. 4, lines 15-24). When the player enters a new grid on the map, the gamemaster determines a clue for transmitting to the wireless communication device. Thus, the wireless communication device merely receives the clue, which is determined by the gamemaster for providing to the player. Therefore, Sprogis teaches determining a clue on a gamemaster when a player enters a new grid, rather than triggering a user navigational event by a wireless computing device.

Accordingly, Sprogis fails to teach each and every limitation of Claim 1 and does not anticipate. Claims 2-5 are dependent on Claim 1 and are patentable for the above-stated reasons, and as further distinguished by the limitations therein. Withdrawal of the rejection is requested.

8. REPLACEMENT CONCLUSION TO THE APPEAL BRIEF

In view of the foregoing arguments, Applicant respectfully submits that the rejections under 35 U.S.C. § 112, first paragraph and 35 U.SC. § 102(e) cannot be sustained and should be withdrawn. Reconsideration of the pending claims and a Notice of Allowance are respectfully solicited.

Please contact the undersigned at (206) 381-3900 regarding any questions or concerns associated with the present matter.

REMARKS

After review of the Notification of Non-Compliant Appeal Brief, Applicant has provided a replacement argument in accordance with 37 C.F.R. 41.37(c)(1)(vii).

Based on the remarks provided in the Appeal Brief, a Notice of Allowance is earnestly solicited. Please contact the undersigned at (206) 381-3900 regarding any questions or concerns associated with the present matter.

Respectfully submitted,

Dated: November 20, 2009

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